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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,975	07/20/2001	Avi Shoshan	25574	6858

7590            09/02/2004

EXAMINER

WILDER, CYNTHIA B

ART UNIT            PAPER NUMBER

1637

DATE MAILED: 09/02/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

<b>Application No.</b>	<b>Applicant(s)</b>	
09/908,975	SHOSHAN ET AL.	
<b>Examiner</b>	<b>Art Unit</b>	
Cynthia B. Wilder, Ph.D.	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 6/15/2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-74 is/are pending in the application.

4a) Of the above claim(s) 1-60 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 61-74 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 15, 2004 has been entered.

#### ***Status of Claims***

Claim 61 has been amended. Claims 1-74 are pending. Claims 1-60 are withdrawn from consideration as being drawn to a non-elected invention. Claims 61-74 are discussed in this office action.

#### ***Previous Rejections***

2. The claim rejection under 35 USC 112 second paragraph is withdrawn in view of Applicant's amendment of the claim. The Claim rejection under 35 USC 102(e) is withdrawn in view of Applicant's amendment of claim 61.

#### ***New Ground of Rejections***

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 61 and 63 is rejected under 35 U.S.C. 102(b) as being anticipated by Breyer et al (JBC, vol. 269, No. 8, pages 6163-69, Feb. 1994). Regarding claim 1, Breyer et al teach a oligonucleotide library comprising a plurality of oligonucleotides each including a unique sequence shared by a set of RNA spliced variants produced from a transcription unit transcribed in the transcriptome, wherein said unique sequence is selected that each oligonucleotide of said plurality of oligonucleotides hybridized to a set of RNA spliced variants produced from only one transcription unit of the transcriptome (abstract and page 6163 and 6164, sections entitled "RT-PCR and Ribonuclease Protection, see also page 6165 , Figure 1B).

Regarding claim 63, Breyer et al teach the oligonucleotide of claim 61, wherein the transcriptome is of a specific tissue (kidney) (see abstract). In view of the foregoing, Breyer et al meets the limitations of claims 61 and 63 of the instant invention.

4. Claims 61-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Amitai et al (US 6625545 B1, filing date August 13, 1998). Regarding claim 61, Amitai et al an oligonucleotide library for detecting messenger RNAs of a transcriptome or a sub-transcriptome comprising a plurality of oligonucleotides each including a unique sequence shared by a set of RNA splice variants produced from a transcription unit transcribed in the transcriptome or a sub-transcriptome, wherein said unique sequence is selected such that each oligonucleotide of aid plurality of oligonucleotides hybridizes to a set of RNA splice variants produced from only one transcription of the transcription or the sub-transcriptome (col. 6, lines 17-31 and col. 9, lines 3-8 and col. 18, lines 44-47).

Regarding claim 62, Amitai et al teach the oligonucleotide library of claim 61, wherein the transcriptome is a human transcriptome (col. 22, lines 26-27).

Regarding claim 63, Amitai et al teach the oligonucleotide library of claim 61, wherein the sub transcriptome is a specific tissue (col. 5, lines 3-9 & 38-41).

Regarding claim 64-66, Amitai et al teach the oligonucleotide library of claim 61 and 64, wherein the sub-transcriptome is a pathological tissue, such a cancer tissue or tissue at different developmental stages (col. 22, lines 23-40).

Regarding claims 67 and 68, Amitai et al teach the oligonucleotide library of claims 61 and 67, wherein the transcriptome is derived from an individual suffering from a disorder, such as cancer (col. 22, lines 23-33).

Regarding claim 69-74, Amitai et al teach a DNA microarray (DNA chip) having attached thereof the oligonucleotide library of claim 61-65 and 67 (col. 23, line 42 to col. 24, line 55). Therefore, Amitai et al meets the limitations of the claims 61-74 of the instant invention.

### ***Conclusion***

5. No claims are allowed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be emailed to [cynthia.wilder@uspto.gov](mailto:cynthia.wilder@uspto.gov). Since email communications may not be secure, it is suggested that information in such request be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

*Cynthia Wilder*  
CYNTHIA WILDER  
PATENT EXAMINER  
8/31/2004